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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,784

02/21/2007

Roger Francis Martin

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1618

NOTIFICATION DATE

DELIVERY MODE

04/01/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
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USPTO@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,784	<b>Applicant(s)</b> MARTIN ET AL.	
	<b>Examiner</b> D. L. Jones	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19, 21, 32 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 21, 32, and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 1/12/11 wherein claims 1-18, 20, 22-31, 33, and 34 were canceled; claims 19, 21, and 32 were amended; and claims 35 was added.

**Note:** Claims 19, 21, 32, and 35 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENT**

2. The Applicant's arguments and/or amendment filed 1/12/11 to the rejection of claims 19-22 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed persuasive for the reasons set forth below.

### **Written Description Rejection**

The 112 first paragraph rejection is WITHDRAWN because Applicant amended the claims to overcome the rejection.

### **112 Second Paragraph Rejections**

All outstanding 112 second paragraph rejections are WITHDRAWN because Applicant amended and/or canceled the claims in order to overcome the rejections.

### **103 Rejection**

The 103 rejection is WITHDRAWN because Applicant amended the claims to overcome the rejection.

## **NEW GROUNDS OF REJECTIONS**

### **112 First Paragraph Rejection (New Matter)**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims were amended to disclose specific cell targeting conjugates set forth in newly added claim 35. However, review of the specification does not disclose the conjugates in the claims. If Applicant is in disagreement with the Examiner's position, it is respectfully requested that Applicant point to page(s) and line number(s) wherein support may be found.

**112 First Paragraph Rejection (Written Description)**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 19, 21, 32, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is reminded that an Inventor is entitled to a patent to protect his work only if he/she produces or has possession of something truly new and novel. The

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invention being claimed must be sufficiently concrete so that it can be described for the world to appreciate the specific nature of the work that sets it apart from what was before. The Inventor must be able to describe the item to be patented with such clarity that the Reader is assured that the Inventor actually has possession and knowledge of the unique composition that makes it worthy of patent protection. The instant application does not sufficiently describe the invention as it relates to the cell conjugates set forth in claim 35. In addition, the instant application does not sufficiently describe the invention as it relates to the tautomers of the cell conjugates encompassed by the instant invention. What the Reader gathers from the instant application is a desire/plan/first step for obtaining a desired result. While the Reader can certainly appreciate the desire for achieving a certain end result, establishing goals does not necessarily mean that an invention has been adequately described.

While compliance with the written description requirements must be determined on a case-by-case basis, the real issue here is simply whether an adequate description is necessary to practice an invention described only in terms of its function and/or based on a disclosure wherein a description of the components necessary in order for the invention to function are lacking. In order to satisfy the written description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the Inventor possessed the claimed invention at the time of filing. In other words, the specification should describe an invention and does so in sufficient detail that one skilled in the art can clearly conclude that the Inventor created what is the claimed. Thus, the written description

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requirement is lacking in the instant invention since the various terms as set forth above are not described in a manner to clearly allow persons of ordinary skill in the art to recognize that Applicant invented what is being claimed.

**112 Second Paragraph Rejection**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 19, 21, 32, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19, 21, 32, and 35: The claims as written are ambiguous because it is unclear what tautomers of the various cell conjugates Applicant is claiming that are compatible with the instant invention.

Claim 35, lines 7: Did Applicant intend to insert 'or' before the structure appearing in line 7.

Claim 35, line 9: The phrase 'I represents the gamma-emitting or positron-emitting moiety' is ambiguous because it is unclear if 'I' in the structure is iodine or if it is a variable since Applicant has defined 'I' as a gamma or positron emitting moiety.

**COMMENTS/NOTES**

9. It should be noted that no prior art has been cited against the instant invention. However, Applicant MUST address and overcome the rejections above. The claims are distinguished over the prior art of record because the prior art neither anticipate nor renders obvious the instant invention.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571)272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. Jones/  
Primary Examiner  
Art Unit 1618

March 27, 2011